

REMARKS

Claims 6, 7, 11-16, 21, 22, 24-28, and 30-39 are pending.

The Office action dated August 28, 2001 rejected claims 6, 7, 11-16, 21, 22, 24-28, and 30-34 as being unpatentable over U.S. Patent No. 6,058,430 to Kaplan ["Kaplan"] in view of U.S. Patent No. 5,818,935 to Maa ["Maa"] and U.S. Patent No. 5,771,354 to Crawford ["Crawford"]. Applicants respectfully disagree. Applicants respectfully add claims 35-39 to focus on aspects of the invention having commercial value different than or in addition to that of the other claims.

Applicants respectfully request reconsideration of the application.

1) In the interest of reaching a shared understanding of the disclosures of Kaplan, Maa, and Crawford, Applicants respectfully make the following observations.

Kaplan

Kaplan describes a television and Internet system that includes a television receiver (10) and an Internet access subsystem (12) connected by a serial link (52). [See Kaplan, Figure 1.]

The Internet access subsystem (12) includes a network interface (42), a CPU and memory (40), an O.S. and browser ROM (44), and a graphics display controller (46).

Apart from the Internet access subsystem (12), the television receiver (10) includes a tuner (20) and an on-screen display processor (22). The on-screen display processor decodes a URL in the vertical blanking interval portion of a television signal and transmits the URL to a processor (40) of the Internet subsystem (12). [Kaplan, 4:58-64.] If the URL is valid, the processor (40) instructs the graphic display controller (46) to signal that a valid URL has been received, and the graphic display controller (46) causes the display of an information symbol, icon, or text message on the screen. [Kaplan, 5:1-9.] Alternatively, an LED flashes to signal that a valid URL has been received. [Kaplan, 5:9:13.]

Then, the user can request (e.g., by pressing a key on a remote control) that the Internet subsystem (12) make a connection to the location specified by the URL. [Kaplan, 5:14-20.] If the user makes such a request, "[t]he OSD processor (22) would receive this request and pass it on to the processor (40). The processor (40) would then begin the connection process to the URL Internet address." [Kaplan, 5:20-23.] In other words, the connection process is initiated immediately after receiving the request from the user.

Maa

Maa describes a system for accessing the Internet based on an Internet information pointer encoded in a video signal. [Maa, Abstract.] An Internet access device (10) includes a TV tuner (14) which extracts a video signal from an RF carrier and a video data extractor (18) which strips the Internet information pointer from the video signal. [Maa, 4:21-31.] The video data extractor (18) passes the pointer to a pointer processing program running on a processing unit (24), which generates and maintains a table of Internet pointers and associated text messages as shown in Figure 3. [Maa, Figure 3, 6:7-29.] “Then, when the viewer wants to access some related Internet site, the viewer can push a button on a remote control to display the table for selection.” [Maa, 6:42-44; *see also* 3:52-55.] “A user can select any of the displayed text message by pressing the pertinent entry number to a remote control. Once this occurs, the operating system on the processing unit will initialize the web browser to the URL pertinent to the selected text message.” [Maa, 7:7-12.] In other words, the table of Internet pointers is updated when an Internet information pointer is received, but the table is not displayed until the user presses a button on a remote control.

Crawford

Crawford describes an online service that supplies automated information processing services (e.g., processing and storage resources) to computer users for a fee. [Crawford, 1:10-12.] A customer computer (50) connects to a host computer (104) of an online service system (100) through a network. The network can use any of various physical layer connection technologies, including cable television links. [Crawford, Figure 4, 16:44-67.] When a customer signs up for a service, the customer can dial a special charge telephone number and a message is displayed describing the services and charges for signup. If the customer stays connected and responds to the signup information, a user password is assigned and software and control information for the service are downloaded. [*See* Crawford, Figure 8A, 28:20-36.]

If the Examiner believes Applicants’ description of Crawford is inaccurate or incomplete, Applicants request the Examiner provide a specific citation to contrary description in Crawford.

2) Kaplan, Maa, and Crawford, taken separately or in combination, fail to teach or suggest at least one limitation of each of the claims 6, 7, 11-16, 21, 22, 24-28, and 30-34.

Kaplan, Maa, and Crawford, taken separately or in combination, fail to teach or suggest at least one limitation of each of claims 6, 7, 11-16, 21, 22, 24-28, and 30-34.

Claim 6 recites:

responsive to a signal from a viewer during the displaying the icon, displaying a graphical control panel operable by the viewer to cause display of the auxiliary data associated with the icon.

Claim 16 recites:

in response to user selection of said icon, displaying a graphical control panel that presents to the user a plurality of options selectable by the user, a first option selectable by the user to indicate desire to return to the displaying the televised advertising message, and a second option selectable by the user to indicate desire to view additional information from the Internet relating to the subject of said advertising message.

Claim 21 recites:

(d) responsive to said indication of viewer interest, displaying a graphical control panel that includes textual data related to said page of supplementary data, the control panel permitting the viewer to signal further interest in viewing the supplementary data;

Claim 30 recites:

responsive to a signal from a viewer during the displaying the icon, displaying a graphical panel that includes a descriptor of the auxiliary data, wherein the panel includes a first graphical control actuatable by the viewer to indicate desire to return to the displaying the television signal, and wherein the panel includes a second graphical control actuatable by the viewer to indicate desire to view the auxiliary data;

Kaplan, Maa, and Crawford, taken separately or in combination, fail to teach or suggest the *timing of the actions* recited in claims 6, 16, 21, and 30, respectively. With reference to claim 6, for example, the references, taken separately or in combination, fail to teach or suggest the timing of *displaying* a graphical control panel *responsive to a signal* from a viewer *during displaying* an icon.

Kaplan describes display of an icon to indicate that a valid URL has been received. [Kaplan, 5:1-9.] A user can then request (e.g., by pressing a key on a remote control) that an Internet subsystem (12) make a connection as specified by the URL. [Kaplan, 5:14-20.] The connection process is initiated immediately after receiving such a request from the user. [Kaplan, 5:20-23.] Kaplan's immediate initiation of the connection process after receiving the request from the user [Kaplan, 5:20-23] leads away from the above-cited language of each of claims 6, 16, 21, and 30, respectively.

Maa describes updating a table of Internet pointers when an Internet pointer is received. [Maa, Figure 3, 6:7-29.] The table is not displayed until a user presses a button on a remote control. [Maa, 6:42-44.] No part of Maa describes displaying the table in response to a signal from the user during display of an icon (the icon being displayed responsive to receipt of an Internet pointer). In contrast, Maa's display of the table when the user presses the button (with no icon display) [Maa, 6:42-44] leads away from the above-cited language of each of claims 6, 16, 21, and 30, respectively.

Crawford describes an online service that supplies automated information processing services (e.g., processing and storage resources) to computer users for a fee. [Crawford, 1:10-12.] When a customer signs up for a service, the customer can dial a special charge telephone number and a message is displayed describing the service and charges for signup. If the customer stays connected and responds to signup information, software and control information for the service is downloaded. [See Crawford, Figure 8A, 28:20-36.] The Examiner writes of "Crawford's method of first asking if the user wants to continue for fee a process and if the user indicates a continued interest then the system proceeds to the Internet." Applicants note that, according to Crawford, the result of a user indicating continued interest is that the user is assigned a password, software and control information are downloaded, etc. [See Crawford, 28:20-36.] Crawford does not involve a user deciding whether or not the system proceeds to the Internet, as the Examiner writes. The customer signup method of Crawford does not relate to transitioning between display of different kinds of content. In any case, no part of Crawford describes transitioning between display of television programming and display of data from a network such as the Internet, and Crawford is even further from teaching or suggesting *the timing of actions* recited in claims 6, 16, 21, and 30, respectively. If the Examiner believes otherwise, Applicants request the Examiner provide a specific citation to such description in Crawford. Crawford does not teach or suggest the above-cited language of each of claims 6, 16, 21, and 30, respectively.

For each of claims 6, 16, 21, and 30, respectively, neither Kaplan, Maa, nor Crawford teaches or suggests the above-cited language. Accordingly, the combination of these references also fails to teach or suggest the above-cited language, and claims 6, 7, 11-16, 21, 22, 24-28, and 30-34 should be allowable. In view of the foregoing remarks, the merits of the separate patentability of dependent claims 7, 11-15, 22, 24-28, and 31-34 are not belabored at this time.

3) The combination of Kaplan, Maa, and Crawford set forth by the Examiner is improper.

In rejecting claims 6, 7, 11-16, 21, 22, 24-28, and 30-34, the Examiner writes of “Crawford’s method of first asking if the user wants to continue for fee a process and if the user indicates a continued interest then the system proceeds to the Internet” [Office action of August 28, 2001, page 4] [“Crawford’s method”]. The Examiner incorporates Crawford’s method into the “control panel design” of Maa. [Office action of August 28, 2001, page 4.] The Examiner then incorporates “Maa-Crawford” into the “graphical display controller 46” of Kaplan. [Office action of August 28, 2001, pages 4-5.] Applicants believe this combination is improper because a) the Examiner uses impermissible hindsight in making the combination; b) the combination changes the principle of operation of Kaplan; and c) Crawford is not analogous prior art. If the Examiner believes Applicants mischaracterize Crawford or the Examiner’s reliance on Crawford, Applicants request the Examiner provide a specific citation to contrary description in Crawford.

Claims 6, 7, 11-16, 21, 22, 24-28, and 30-34 should be allowable. Such action is respectfully requested.

a) The combination of Kaplan, Maa, and Crawford set forth by the Examiner uses impermissible hindsight.

In rejecting claims 6, 7, 11-16, 21, 22, 24-28, and 30-34, the Examiner incorporates Crawford’s method and the “control panel design” of Maa into the “graphical display controller 46” of Kaplan. [Office action of August 28, 2001, pages 4-5.] Even if, assuming for the sake of argument, Crawford’s method and the “control panel design” of Maa could be incorporated into the Kaplan system, the result would not be the combination set forth by the Examiner. Rather, the combination set forth by the Examiner uses impermissible hindsight reasoning. One of ordinary skill in the art would not be motivated to modify Kaplan with Maa and Crawford as the Examiner has done. [See M.P.E.P. 2141.01.III, M.P.E.P. 2145.X.A.]

In general, the Examiner has selected different features from three different references. One of ordinary skill combining the selected features at the time of the invention would have produced a single system in which each of the selected features was independently usable. To the extent the Examiner deviates from this system (namely, by imposing a specific order on use of the selected features dependently as part of a single process), the Examiner is relying on improper hindsight reasoning that uses knowledge gleaned from Applicants’ disclosure.

In particular, one of ordinary skill in the art incorporating Crawford's method and the "control panel design" of Maa into the "graphical display controller 46" of Kaplan would have produced a system that:

- 1) displays a symbol, icon, or text message indicating that a valid URL has been received (as in Kaplan);
- 2) immediately initiates a connection process when a user requests (e.g., by pressing a key on a remote control) (as in Kaplan);
- 3) generates and maintains a table of URLs and related information (as in Maa);
- 4) displays the table when the user presses another button on the remote control (as in Maa); and
- 5) uses a customer signup process after the user switches to the network (as in Crawford).

Such a system would be different than, and would not teach or suggest, the above-cited language from each of claims 6, 7, 11-16, 21, 22, 24-28, and 30-34, respectively. To the extent the Examiner deviates from such a system when rejecting claims 6, 7, 11-16, 21, 22, 24-28, and 30-34, the Examiner is relying on improper hindsight reasoning that uses knowledge gleaned from Applicants' disclosure. For example, the Examiner writes that the motivation to combine Maa/Crawford with Kaplan "would have been to add to Kaplan's system flexibility by giving the user an easy-to-use interface for determining whether the system should [proceed] to the Internet." [Office action of August 28, 2001, page 5, citing Crawford, 28:1-36.] The Examiner relies on improper hindsight reasoning that uses knowledge gleaned from Applicants' disclosure about what constitutes an easy-to-use and effective interface.

b) The combination of Kaplan, Maa, and Crawford set forth by the Examiner changes the principle of operation of Kaplan.

The combination of Kaplan, Maa, and Crawford set forth by the Examiner also changes the principle of operation of Kaplan. Thus, one of ordinary skill in the art would not be motivated to modify Kaplan with Maa and Crawford as the Examiner has done. [M.P.E.P. 2143.01, "THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE."]

In Kaplan, if the user requests a connection after seeing an information symbol, icon, or message, the processor *immediately* initiates the connection process. [Kaplan, 5:20-23.] Assuming

for the sake of argument that the Kaplan system could be modified to incorporate the “control panel design” of Maa and the Crawford method, as the Examiner has done, such a modification would delay the initiation of the connection process. Thus, such a modification changes the principle of operation of Kaplan, in which the processor *immediately* initiates the connection process if the user requests a connection after seeing an information symbol, icon, or message.

c) Crawford is not analogous prior art.

Crawford is not analogous prior art to Applicants’ invention. Thus, one of ordinary skill in the art would not be motivated to combine Crawford with Kaplan and Maa, as the Examiner has done. [See M.P.E.P. 2141.01(a).]

Crawford is not in the field of Applicants’ endeavor. Claims 6, 7, 11-16, 21, 22, 24-28, and 30-34 are directed to transitioning between display of television programming and display of data from a network such as the Internet. In contrast, Crawford is directed to online services (e.g., information processing services) for computer users. [Crawford, 1:9-12.] Crawford mentions “TV” and “television” only in the context of a cable television link, which is used as a physical layer connection medium (e.g. as a cable modem). Crawford does not relate television display, and is even further removed from transitioning between display of television programming and display of data from a network such as the Internet.

For similar reasons, Crawford is not reasonably pertinent to the particular problem with which Applicants’ invention is concerned.

Applicants also note that the classes into which the Examiner previously placed claims 6-16 and 19-24 (namely, classes 348 or 710) [Office action of April 26, 2000, page 2] are different than the class of Crawford (namely, class 395).

4) Applicants respectfully add claims 35-39.

Applicants respectfully add claims 35-39 to focus on aspects of the invention having commercial value different than or in addition to that of the other claims.

Specifically, claims 35-39 are directed to a set-top box with architectural and functional aspects. Rather than rely on the television interface and user input device interface of a television receiver, the set-top box itself includes a television interface and user input device interface, as well as a network interface, memory, and processing unit. [See, e.g., Application, Figures 2 and 3.] The

processing unit of the set-top box causes display of television programming, and then, responsive to receipt of logical address link data, causes display of an icon during the display of television programming.

5) Declaration from inventor Christopher White

Applicants enclose a Declaration of Prior Invention from Christopher White, which relates to a previous rejection in the present application. Applicants received the Declaration after filing the Amendment dated July 24, 2001. Applicants enclose the Declaration for the sake of completeness.

6) Request for an Interview


If the Examiner finds that the amendment does not make the application allowable, the Examiner is requested to contact the undersigned attorney at (503) 226-7391 prior to issuance of the next communication in order to arrange a telephonic interview. It is believed that a brief discussion of the merits of the present application (for example, the rejections of claims 6 and 30) will allow the application to be passed to issue. Applicant submits the foregoing remarks so that the Examiner may fully evaluate Applicants' position, thereby enabling the interview to be more productive.

CONCLUSION

Claims 6, 7, 11-16, 21, 22, 24-28, and 30-39 should be allowable. Such action is respectfully requested.

Respectfully submitted,

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